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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,682	10/05/2001	Jerome Fournier	Q66648	1857

7590

06/05/2003

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EXAMINER

GRAY, JILL M

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,682

Applicant(s)

FOURNIER ET AL.

Examiner

Jill M Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The rejection of claims 1-15 under 35 U.S.C. 112, second paragraph is moot in view of applicants' amendments.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-2, 4, 9-10 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Terry et al, 6,329,488 b1 (Terry).

Terry teaches a composition comprising a silane copolymer prepared from a urethane prepolymer and an alkoxysilane, further teaching the addition of a Fe compound as required by claims 1-2 and 10. The alkoxysilane can be a trialkoxysilane as set forth in claim 4. See Examples. In addition, Terry teaches that the reaction is formed in the presence of a catalyst such as dibutyl tin, as required by claim 12. See column 5, lines 10-20, and 44-47. Claim 9 is drawn to the future intended use of the composition of claim 1, which does not provide patentable limitations to the claim.

Accordingly, the teaching of Terry anticipates the invention as claimed in claims 1-2, 4, 9-10, and 12.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaopo et al, 4,769,287 (Zaopo) in view of Keane et al, 4,503,124 (Keane), for reasons of record.

Zaopo teaches an insulation material and insulated cable comprising a thermosetting or thermoplastic resin and a silanic monomer as required by claim 1. The resin can be polyester or polyimide as required by claim 2 and the silanic monomer is an alkoxysilane as required by claim 4. See column 2, lines 10-22 and Examples. In addition, Zaopo teaches that his reaction is performed in the presence of a catalyst such as dibutyl tin, as required by claim 12, and the application of his composition onto conductor wire, per applicants' claim 13. See Example IV. Zaopo does not teach the incorporation of mineral filler. ✓

Keane teaches wire enamel composition for insulated cables comprising thermosetting or thermoplastic resin having mineral filler incorporated therein. The resins and mineral filler are each of the type contemplated by applicants in claims 2 and 5-6. See abstract. In addition, Keane teaches that the mineral filler can be added in amounts within applicants' range as set forth in claim 7 (column 2, lines 19-20). Keane teaches that the addition of his mineral filler results in a corona-resistant wire enamel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Zaopo by adding a mineral filler of the type contemplated by Keane in order to impart corona resistant properties to the

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resultant insulated cable. Regarding claim 3, it is the examiner's position that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum workable ranges by routine experimentation. As to claim 11, it is the examiner's position that the solvent in a reaction is not a result effective variable, and therefore is not construed to be a matter of invention in the absence of clear factual evidence to the contrary. It is always obvious to choose and determine the solvents best suited for the polymer resin of choice. Claims 9 and 15 are drawn to the future intended use and do not provide specific positive recitation of patentable limitations. As to claims 13 and 14, the prior art teaches the formation of wires and cables, accordingly, it would have been obvious to choose the specific wire substrate commensurate with the desired end use.

Therefore, the combined teaching of Zaopo and Keane would have rendered obvious the invention as claimed in present claims 1-15.

Response to Arguments

4. Applicant's arguments filed March 17, 2003 have been fully considered but they are not persuasive.

Applicants argue that Zaopo does not teach a copolymer of base polymer and silanic monomer.

In this regard, Zaopo clearly teaches modifying the base polymer through graft polymerizing. This necessarily results in a copolymer.

Applicants argue that Zaopo does not teach any incorporation of filler in his compound.

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In this concern, the examiner has relied upon the motivation provided in the teachings of Keane to incorporate mineral filler into the composition of Zaopo.

Applicants argue that Zaopo is non-analogous art.

5. In response to applicant's argument that Zaopo is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Zaopo teaches a composition having high temperature resistance.

Applicants have not clearly distinguished that which they regard as their invention.

No claims are allowed.

Conclusion

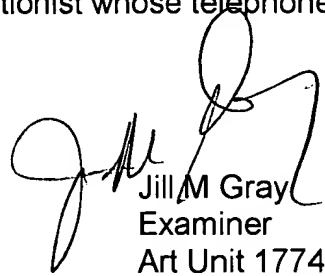
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M Gray whose telephone number is 703.308.2381. The examiner can normally be reached on 10:00-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703.308.0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.5408 for regular communications and 703.305.3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0651.



Jill M Gray
Examiner
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jmg
June 2, 2003